

Applicants : Richard J. Zeman and Joseph D. Etlinger
Serial No. : 09/611,652
Filed : July 7, 2000
For : TREATING NEURAL CONDITIONS RESULTING FROM
: SPINAL CORD CONTUSIONS AND OTHER CAUSES

Page 2

1.131, and consistent with the law established in *In re Katz*, 215 USPQ 14 (CCPA 1982), establishing that Zeman et al., *Experimental Neurology* 159:267-273 (1999) ("Zeman et al.") is the inventors' own work. See also MPEP 2132.01.

Rejection under 35 U.S.C. 102(a)

Claims 37, 40, and 44-46 stand rejected under 35 U.S.C. 102(a) as being anticipated by Zeman et al. Applicants request reconsideration and withdrawal of this rejection in light of the enclosed Declaration of the Inventors and the following discussion.

As established by the enclosed Declaration of the Inventors, the work disclosed in Zeman et al. was the inventors own work, and is therefore not available as a prior art reference under 35 U.S.C. 102(a). See *In re Katz*, 215 USPQ 14, 17 ("...one's own work is not prior art under §102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under §102(a). Disclosure to the public of one's own work constitutes a bar to the grant of a patent claiming the subject matter so disclosed [or subject matter obvious therefrom] only when the disclosure occurred more than one year prior to the date of the application ..."). A Declaration of the type presented herewith is also sufficient to establish that inventors Zeman and Etlinger are the sole inventors and thus remove the Zeman et al. reference against the presently claimed subject matter. *In re Katz*, 215 USPQ at 16.

Based on the above discussion, Zeman et al. cannot be used as prior art against the instant invention. Accordingly, applicants respectfully request withdrawal of the rejection under 35 U.S.C. 102(a).

Applicants : Richard J. Zeman and Joseph D. Etlinger
Serial No. : 09/611,652
Filed : July 7, 2000
For : TREATING NEURAL CONDITIONS RESULTING FROM
: SPINAL CORD CONTUSIONS AND OTHER CAUSES

Page 3

Rejection under 35 U.S.C. 103(a)

Claims 1, 4, 37, 40 and 42-46 stand rejected under 35 USC 103(a) as being unpatentable over Zeman et al. and Etlinger et al., of record. Applicants respectfully request reconsideration and withdrawal of this rejection based on the following discussion.

As discussed above in the remarks relating to the current rejection under 35 USC 102(a), Zeman et al. cannot be used as a prior art reference for this application, since that reference was the inventors' own work and was published in September 1999, less than one year prior to the filing date of the current application. Accordingly, the teachings of Zeman et al. cannot be used in the determination of obviousness. Since Etlinger does not teach the use of a β_2 adrenergic agonist following spinal cord contusion injury, that reference does not disclose all limitations of the rejected claims, as required for a rejection under 35 USC 103(a). Additionally, since scoliosis is a fundamentally different condition from spinal cord contusion injury (see Declaration of Sandar C. Sharma, Ph.D. Under 37 C.F.R. 1.132, submitted on March 31, 2003 in this case), the skilled artisan would not consider the instant invention obvious based on Etlinger et al. alone, without the teachings of Zeman et al. Accordingly, the instant invention is not obvious based on Etlinger et al. alone.

In light of the above discussion, in combination with the enclosed Declaration of the Inventors, applicants respectfully request withdrawal of the instant rejection under 35 U.S.C. 103(a).

Applicants : Richard J. Zeman and Joseph D. Etlinger
Serial No. : 09/611,652
Filed : July 7, 2000
For : TREATING NEURAL CONDITIONS RESULTING FROM
: SPINAL CORD CONTUSIONS AND OTHER CAUSES

Page 4

Conclusion

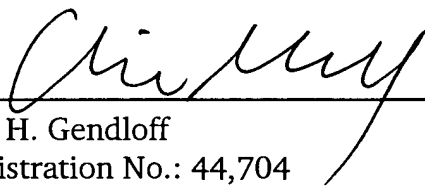
In light of the above discussion, applicants respectfully request withdrawal of all current rejections and the search and examination of the claims encompassing the nonelected species. If there are any minor issues preventing this, applicants urge that the examiner contact the undersigned attorney.

It is believed that no fee is required with the amendment. However, if any unanticipated payment is required to maintain the pendency of this application, authorization is given to withdraw those fees from Deposit Account No. 01-1785.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
Attorneys for Applicant
90 Park Avenue
New York, New York 10016
(212) 697-5995

Dated: New York, New York
September 16, 2003

By: 
Elie H. Gendloff
Registration No.: 44,704